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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,982	07/05/2001	Oded Kafri	P-2033-US	7273

7590 12/09/2002

Eitan Pearl Latzer & Cohen Zedek  
One Crystal Park Suite 210  
2011 Crystal Drive  
Arlington, VA 22202-3709

EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/830,982

Applicant(s)

KAFRI, ODED

Examiner

Allan Hoosain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment A, 9/30/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## FINAL DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-4, 6-7, 9-10, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bartholomew et al.** (US 5,557,659).

As to Claim 1, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a telephone call comprising the steps of:

routing the incoming telephone call to a dedicated server (Col. 37, lines 27-34);

identifying the number being dialed (Col. 37, lines 45-51);

associating at least one email address with said dialed number (Col. 37, lines 45-51); and

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forwarding the voice message as an email message to said at least one email address via the Internet (Col. 39, lines 11-16).

As to Claims 3,6, **Bartholomew** teaches a method according to claim 1, and further comprising the steps of:

storing said voice message in a voice box (Col. 38, lines 11-20); and

the recipient retrieving said voice message by telephone (Col. 38, lines 11-20).

As to Claim 4, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a telephone call in email message format to a recipient, the method comprising the steps of:

the caller dialing a telephone number associated with a dedicated server (Col. 37, lines 27-34);

identifying the telephone number of the caller (Col. 37, lines 27-32);

the caller entering the telephone number of the recipient of the telephone call (Col. 37, lines 47-51);

associating at least one email address with the telephone number of the recipient (Col. 37, lines 47-51); and

forwarding the voice message as an email message to said at least one email address via the Internet (Col. 39, lines 11-16).

As to Claims 7,9, **Bartholomew** teaches a method according to claim 4, and further comprising the step of:

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verifying whether the caller's telephone number matches the registered telephone number of the caller (Col. 37, lines 27-34).

As to Claims 10 and 12-14, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a facsimile message in email message format to a recipient, the method comprising the steps of:

the caller dialing a facsimile number associated with a dedicated server (Col. 37, lines 27-34 and Col. 39, lines 55-64);

identifying the telephone number of the caller (Col. 37, lines 27-34);

the caller entering the facsimile number of the recipient of the facsimile (Col. 37, lines 45-51);

associating at least one email address with the facsimile number of the recipient (Col. 37, lines 47-51); and

forwarding the facsimile message in email message format to said at least one email address via the Internet (Col. 39, line 55 through Col. 40, line 25).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 2,5,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartholomew** in view of **Bobo, II** (US 5,675,507).

As to Claims 2,5, **Bartholomew** teaches a method according to claim 1 wherein said step of forwarding comprises the steps of:

digitizing the voice message into a wave file; and

attaching said wave file to the email message;

**Bartholomew** does not teach the following limitation:

“wav file”

However, it is obvious that **Bartholomew** suggests the limitation. This is because **Bartholomew** teaches instructions for delivering the voice message (Col. 38, lines 7-14 and Col. 40, lines 33-41). These instructions suggest wav files. **Bobo, II** teaches delivering voice messages in wav formats (Col. 13, lines 1-14). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add wav file capability to **Bartholomew's** invention for voice message delivery instructions as taught by **Bobo, II's** invention in order to provide message delivery in particular formats.

As to Claim 11, **Bobo, II** teaches a method according to claim 10, wherein said step of forwarding comprises the steps of:

**Bartholomew** does not teach the following limitations:

(i) converting the facsimile message into a TIF file

(ii) attaching said TIF file to the email message

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However, it is obvious that **Bartholomew** suggests the limitation. This is because **Bartholomew** teaches instructions for delivering messages in any formats (Col. 40, lines 33-41). These teachings suggest TIF files. **Bobo, II** teaches delivering facsimile messages in TIF formats (Figure 6). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add TIF file capability to **Bartholomew's** invention for facsimile message delivery as taught by **Bobo, II's** invention in order to provide message delivery in particular formats.

5. Claims 8,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartholomew** in view of **Hyde-Thomson** (US 5,557,659).

As to Claims 8,13, **Bartholomew** teaches a method according to claim 7, and if the identified telephone number does not match the registered telephone number of the caller, further comprising the step of:

**Bartholomew** does not teach the following limitation:

“only forwarding the voice message if a correct password and the registered telephone number associated with the caller is verified”

However, it is obvious that **Bartholomew** suggests the limitation. This is because **Bartholomew** teaches recognizing callers telephone numbers (Col. 37, lines 27-35 and 39-45). **Hyde-Thomson** teaches password verification of callers (Figure 14, label 1406). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add password capability to **Bartholomew's** invention for recognizing callers as taught by **Hyde-Thomson's** invention in order to provide desired services to callers.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection and the following:

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Swartz** (US 6,445,694) teach a telephony system that allows users to send e-mails with attachments.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**


(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The  
examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
**12/5/02**